

09-09-03

AF/2863

#2 Response

Patent Application
USSN 09/714,385

Atty Docket No. 8367-86196

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John R. Kochan, Jr.

For: Flow Rate Calculation System

Serial No. 09/714,385

Filed: November 16, 2000

Examiner Huan Hien Vo

Group Art: 2863

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as Express Mail in an envelope addressed to: Mail Stop AF, Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, Virginia 22313-1450, on this date.

Date: 9-8-03

David B. Jones

Express Mail No.: EV 337103182 US

REQUEST FOR RECONSIDERATION, RESPONSIVE TO OUTSTANDING
FINAL OFFICE ACTION

MAIL STOP AF
Commissioner for Patents
P. O. Box 1450
Arlington, Virginia 22313-1450

Sir:

This request for reconsideration is being submitted in response to a Final Office Action mailed July 1, 2003. In this Final Office Action all of the pending claims 1-32 and 34-40 were finally rejected pursuant to 35 U.S.C. §102 (b) as being anticipated by Winssenbach et al, U.S. Patent 5,633,809.

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The Final Office Action was in response to an Amendment received March 3, 2003 at the Patent Office. In the Final Office Action, the Examiner stated:

"Applicant's arguments filed 03/03/2003 have been fully considered but they are not persuasive. Applicant's argument [sic] that the references fail to anticipate the claimed subject matter." [page 3, Office Action]

Neither the above quote nor any other portion of the Office Action refers to the fact that the March 3 Amendment included as an attachment a specific, factual Declaration of the inventor, Mr. A. Belehraddek, Jr. setting forth technical reasons as to why the system of the Wissenbach et al patent did not include specific limitations of independent Claims 1, 20 and 34. Those claims and their related dependent claims had all been rejected as anticipated by Wissenbach et al in a prior, non-final Office Action. No reference whatsoever in the Final Office Action was made to Mr. Belehraddek's specific factual statements as to why Wissenbach et al does not anticipate the subject independent claims, as well as the respective dependent claims.

The fact that the Final Office Action failed to specifically address the detailed statements of Mr. Belehraddek's Declaration, controverting the Examiner's earlier conclusion of anticipation, fails to comply with the mandate of the Federal Circuit as followed by the Board of Patent Appeals and Interferences. The Federal Circuit has made it clear, relative to Declaration practice pursuant to 37 CFR 1.132, that where an applicant responds to the Examiner's *prima facie* case, in this instance, of anticipation, by a showing of facts which support the opposite conclusion, the holding of that *prima facie* case of anticipation "being but a legal inference from previously uncontradicted evidence, is dissipated." In re Piasecki, 745 F.2d 1468, 1471 223 USPQ 785, (Fed. Cir. 1984). The Federal Circuit went on in Piasecki to state that:

"Regardless of whether the *prima facie* case could have been characterized as strong or weak, the examiner must consider all of the evidence anew." Pisaecki, pg. 1472.

The Federal Circuit then went on to quote with approval from In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976) namely:

When *prima facie* [anticipation] is established and evidence is submitted in rebuttal, the decision-maker must start over.... An earlier decision should not, as it was here, be considered as set in concrete, and applicant's rebuttal evidence then be evaluated only on its knockdown ability. Analytical fixation on an earlier decision can tend to provide that decision with an undeservedly broadened umbrella effect. *Prima facie* obviousness [here anticipation] is a legal conclusion, not a fact. Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself."

The Final Office Action and its failure to consider facts set forth in Mr. Belehradek's Declaration reflects the evils that the PisaECKi decision has directed the Patent Office to avoid. By way of example, and not limitation, Mr. Belehradek pointed to the following facts in his Declaration, which rejects the Examiner's conclusion of anticipation:

1. "Wissenbach et al take in signals from a variety of different types of flow sensors, or fluid monitoring sensors, and carry out various control functions. Wissenbach et al does not estimate a quantity of pumped fluid based on a user entered expected flow rate and one or more pumping time intervals as claimed." (Belehradek Declaration, para. 6, pg. 1)

2. "Wissenbach et al expressly describes the use of flow sensors to carry out control functions. In this regard, they state:

'A multi-function fluid flow monitoring apparatus capable of measuring fluid flow-related variables of a fluid in a channel on the basis of signals from any one or more of a plurality of different types of flow sensors.'" (Belehradek Declaration, para. 7, pg. 2)

3. "Wissenbach et al in a block diagram, Fig. 5, disclose program storage (flash memory) and data storage (RAM). There is no disclosure in Fig. 5 nor in the detailed description of Wissenbach et al relative to Fig. 5 of any capability

or 'circuitry for storing a manually settable fluid flow rate parameter' as referred to on page 2, lines 10, 11 of the Office Action". [dated December 2, 2002] (Belehradek Declaration, para. 7, pg. 3.)

4. "The monitoring system of Wissenbach, et al. is driven by signals from the various types of flow sensors to produce a quantity of fluid flow based on actual physical measurements of flow rate. For example, as described by Wissenbach et al:

'The microprocessor of the apparatus, on the basis of inputs from sensor 31 processed by control module 30, converts the level of reading to a flow rate based on the level-to-flow relationship of the channel configuration. The flow rate relationship is determined on the basis of the dimension, declination and inside roughness of the pipe.'" (Belehradek Declaration, para. 7, pg. 4)

5. "I have also compared the structure of Wissenbach et al to pending claim 1. Pending claim 1 includes:

'circuitry for storing a manually settable fluid flow rate parameter, coupled to the control circuitry.'

As discussed above, the above circuitry is simply not present in Wissenbach et al. Neither the block diagram of Fig. 5, nor the text of Wissenbach et al disclose or describe the circuitry for storing quoted above." (Belehradek Declaration, para. 7, pg. 5)

6. "I have also compared Wissenbach et al to the wording of amended claim 20. Amended claim 20 includes the following circuitry not present in Wissenbach et al:

'circuitry, coupled to the power supply, wherein the circuitry stores an expected flow rate parameter in at least one flow delivery interval.'

Wissenbach et al disclose a monitoring system which responds to signals from various fluid flow sensors which measure actual flow in a pipe." (Belehradek Declaration, para. 7, pg. 5)

7. "I have also compared claim 34 to the monitoring circuitry of Wissenbach et al. Claim 34 includes:

a manually operable input device for enabling the user to enter an expected flow rate parameter ... and instructions, executable by the control circuitry for estimating a quantity of pumped fluid based on only the expected flow rate [sic] parameter and the or more time intervals.

Wissenbach et al do not provide any capability enable a user to enter an expected 'flow rate parameter' which parameter is then used to estimate pumped volume as claimed. Instead, Wissenbach et al. establish a flow rate parameter based on actual measurements from flow sensors as described above and use that measured parameter in determining fluid volume." Belehradek Declaration, para. 7, pg. 6)

The above quoted sequence of some of the factual statements from the Mr. Belehradek's Declaration is in accordance with applicant's burden of rebuttal, namely, "a showing of facts supporting the opposite conclusion". Piasecki, supra. In Ex parte Meyer, the Board of Patent Appeals and Interferences stated relative to the effects of two Declarations as submitted by the inventor therein pursuant to 37 CFR 1.132, that:

"In considering these documents, we are mindful of our duty to reweigh the entire merits of the application and hence consider all the evidence of record anew." Ex parte Meyer, 6 USPQ 2nd 1966 ED Pat Appeals and Interferences, 1988 (1968).

The silence in the outstanding Final Office Action is not in keeping with the Office's obligation to "reweigh the entire merits of the application." Meyer, supra. ~~Further, the complete failure to address the specific factual statements of the~~ Belehradek Declaration fails to comply with the express requirements of the Manual of Patent Examination Procedure wherein it is stated:

"Evidence traversing rejections must be considered by the examiner when ever present. All entered affidavits, declarations and other evidence traversing rejections are acknowledged and commented upon by the Examiner in the next

succeeding action ... Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements, such as "the Declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims", without explanation supporting such findings, are insufficient." (MPEP 760.01 p. 700-236, Feb. 2003, revision).

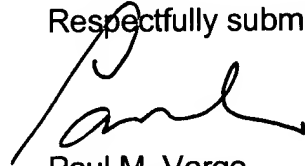
Mr. Belehradek's Declaration sets forth specific facts which controvert the Examiner's conclusion of anticipation by Wissenbach et al. These factual statements dissipate the Examiner's prior conclusion of anticipation. These factual statements expressly point out specific limitations of independent Claims 1, 20 and 34 which are not present in Wissenbach, et al. They were not addressed in the Final Office Action.

The Examiner's Final Office Action has failed the requirements of the Federal Circuit, the Board of Patent Appeals and Interferences as well as the MPEP. The Final Rejection should be withdrawn. A new Office Action which specifically addresses the statements of Mr. Belehradek's Declaration, as required by the Federal Circuit, the Board of Appeals and the MPEP, should be issued, or, a Notice of Allowance should be issued.

Applicant's attorney will contact the Examiner in a few days for the purpose of scheduling an interview to discuss the issue further.

Allowance of the application is respectfully requested.

Respectfully submitted,



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